

REMARKS

This is intended as a full and complete response to the Office Action dated December 27, 2004.

Claims 1-26 remain in this application. Claims 10 and 14 are currently amended.

Claims 10, 14 and 15 were rejected under 35 U.S.C. § 112, second paragraph as indefinite for lacking antecedent basis.

Claims 1, 2, 4, 5, 7, 8, 10, 12, 16-18, 20, 21, 23 and 25 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,537,954 to Beeghly et al. ('954).

Claims 1-5, 7, 16-18, 21, 23, 25 and 26 were rejected under 35 U.S.C. § 102(b) as anticipated by German Patent No. DE 20021260U1. (DE260).

Claims 6, 9, 11, 19, 22 and 24 were rejected under 35 U.S.C. § 103(a) for obviousness as being unpatentable over U.S. Patent No. 5,537,954 to Beeghly et al. ('954).

Claims 13-15 were rejected under 35 U.S.C. § 103(a) for obviousness as being unpatentable over U.S. Patent No. 5,537,954 to Beeghly et al. ('954) in view of Japanese Patent Number JP10113088 (JP088)

The period for response has been extended until April 27, 2005 by a one-month Request for Extension of Time Under 37 C.F.R. § 1.136(a). Accordingly, this response is being presented in a timely manner.

This response is being filed in accordance with recently revised 37 C.F.R. § 1.121, as set forth in 68 F.R. 38611 (June 30, 2003). If the amendment is considered to be not in compliance with recently revised 37 C.F.R. § 1.121, the Examiner is respectfully requested to contact the undersigned at his earliest possible convenience.

Reexamination of the application as amended, reconsideration of the rejections, and allowance of the claims remaining for consideration are respectfully requested.

AMENDMENTS TO THE APPLICATION

Entry of the amendments to the application is respectfully requested. As detailed below, they introduce no new matter.

The paragraph at page 7 lines 6 to 16 was amended to correct a word-processing error. Specifically, the word “of” was replaced with the word “or”.

Claim 10 was amended to correct a word-processing error. Specifically, the word “blanket” was changed to “cover”. Support for this amendment is found at page 3 lines 9 to 15 wherein it is described that the invention is a cover, and that the description will focus on the cover being a blanket. No new matter has been added by this amendment.

Claim 14 was amended to change “the stifle” to “a stifle”, also a word-processing error. Accordingly, no new matter has been added by this amendment.

Accordingly, entry of the amendments is respectfully requested.

#### SUMMARY OF THE OFFICE ACTION

In the Office Action, the Examining Attorney rejected claims 1-26 of the present application under 35 U.S.C. §§ 112, 102 and 103. The claims of the Application have been amended above. These amendments to the claims should obviate some of the Examiner’s rejections. To the extent that these amendments do not address Examiner’s rejections, Applicant respectfully traverses these rejections for the reasons set forth below. In light of the amendments clarifying the invention and the arguments traversing these rejections, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections and allow the application to issue.

#### CLAIM REJECTIONS UNDER 35 U.S.C. § 112

Claims 10, 14 and 15 are presently rejected by Examiner under § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, the Examiner has noted in claim 10, that the phrase “said animal blanket” lacks prior antecedent basis. This has been fully addressed by amendment, and Applicant assumes that the rejection has been overcome. Examiner has

also rejected claim 14 and claim 15 because the phrase “the stifle” lacks antecedent basis. This has been fully addressed by amendment and Applicant assumes that the rejection has been overcome.

Applicant has addressed Examiner’s rejections under 35 USC § 112, second paragraph by way of amendment and therefore respectfully requests Examiner to withdraw this § 112 rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Beeghly et al., United States Patent Number 5,537,954 ('954)

Claims 1,2,4,5,7,8,10,12,16-18,20,21,23 and 25 are presently rejected under § 102(b) as being anticipated by Beeghly et al., United States Patent Number 5,537,954 ('954). Examiner is of the opinion that '954 teaches an animal cover having adjustable temperature altering regions allowing for the specific targeting of various body areas on a variety of differently sized animals, and methods of delivering this targeted temperature altering regimen to these specific areas of an animal's body. For the reasons set forth below, this rejection is traversed and the Examiner is respectfully asked to reconsider and withdraw this holding.

Not unlike a determination of infringement, a determination of anticipation, as well as obviousness, involves two steps. First is construing the claim followed by, in the case of anticipation or obviousness, a comparison of the construed claim to the prior art. *Key Pharmaceuticals Inc. v. Hercon Laboratories Corp.*, 161 F.3d 709, 48 USPQ2d 1911 (Fed. Cir. 1998). In *Key Pharmaceuticals Inc.*, the issue of anticipation turned on claim interpretation.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of that claim. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1574, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984); *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978). Moreover, anticipation under 35 U.S.C. § 102 requires that the single source must disclose all of the claimed elements “arranged as in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) The anticipatory reference must also

“sufficiently describe the claimed invention to have placed the public in possession of it.” *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1572, 24 U.S.P.Q. 2d 1321, 1332 (Fed. Cir. 1992). As the Federal Circuit has held, to constitute an anticipatory reference, the prior art must possess an enabling disclosure. *Scipps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1578, 18 U.S.P.Q. 2d 1001, 1011 (Fed. Cir. 1991).

Claim 1:

Examiner is of the opinion that the ‘954 reference teaches an animal cover 10 comprising a body 12 having an interior and exterior side; a plurality of cavities 14,21,22,20,34 strategically located within the body; and a temperature altering device 40. (Emphasis added). There is certainly no indication within the ‘954 patent that that patent discloses strategically located cavities. Examiner’s opinion is addressed in detail below.

Applicant disagrees with Examiner that ‘954 teaches a plurality of cavities strategically located within the body. The “affixed pockets” (pockets 14,21,22,20,34) of the ‘954 reference are hardly strategic in their described location. In point of fact, claim 1 of the ‘954 patent describes the pockets as being “affixed to the garment at any of various locations.” But the specification and the figures, particularly figures 1-5, do not disclose these pockets as being affixed to any more than a single location. There is not one mention of the animal’s anatomy with respect to the location of the pockets 14,21,22,20,34. Examiner’s point that the pockets are strategically placed on the ‘954 pet sweater is not clear by reading the ‘954 patent. It is unclear how the ‘954 reference enables locating a pocket at the stifle joint and adjusting that pocket to precisely target the stifle, for example, as claimed in the above application. There is simply no teaching of any strategy to be employed regarding the attachment of the pockets to the ‘954 pet sweater. Under *Scripps*, the ‘954 reference cannot enable strategically locating cavities at a specific anatomy of the animal user for delivering a targeted temperature altering regimen.

In the present application, on the other hand, there is a therapeutic strategy to be utilized relating to the location of the pockets. The present application “strategically” places the pockets along various location of the animal cover in order to

deliver a temperature-altering regimen to a specifically defined location of the animal's body (page 1 lines 3-5). The invention is a cover that "delivers a temperature altering regimen directly to a specific location on the horse's body" (page 3, lines 29-30). The device is "adjustable, allowing the temperature altering regions to precisely fit a variety of differently sized horses on a variety of body areas" (page 3 line 30 to page 4 line 2). The cavities are positioned on the blanket to contact the horse's spine and spinal muscles, shoulder muscles, hip muscles, stifle joint and c-spine (page 4 line 27 to page 5 line 4). "Cavities 16 can be located at any portion of the horse blanket that is desired. For example, in figure 1B, the cavities are shown strategically located to contact the horse's thoracic cavity" (page 5, lines 5-7). A temperature altering device can be placed on the flap 12 of the blanket to deliver a temperature altering regimen to the stifle joint, inner thigh, groin and or other horse anatomy positioned in that region (page 5 line 26 to page 6 line 2). The cavity can be adjustable along flap 12 for proper positioning of the temperature altering device, and such adjustment can be accomplished in a variety of ways, including having a cavity that slides along the flap, having a temperature altering device that slides within the flap or other means allowing adjustable positioning of the temperature altering device on the horse and once positioned the temperature altering device is secured in position on the cover (page 6 lines 12 to 23. Emphasis added.) Reading the claims in light of the specification, it is apparent that the current invention is not directed towards a cover simply having pockets for the delivery of heat, as is described in '954, but instead is describing the targeted delivery of a temperature altering regimen to a precise location of the animal's body. Such delivery is useful for targeting a hot/cold treatment to a part of the animal's anatomy.

It is clear that the '954 reference makes no mention of any anatomy of the animal wearer of the disclosed heated pet sweater, nor does the reference describe how its pockets would be adjustably positioned in any location on the sweater. In fact, the '954 reference states that "pockets 14 are sewn or otherwise bonded to the garment" (column 5, lines 35-36), and such a permanent affixing of these pockets teaches away from the adjustable pockets for delivering a temperature to a specific targeted area of the body as described in the current invention.

The ‘954 reference does not disclose or suggest adjustably positioned pockets for delivering a targeted temperature altering therapy to a specific location of an animal’s anatomy. Anticipation requires that all of the claim elements are present in a prior art reference arranged as recited in the claim. *Richardson v. Suzuki Motor Co.* For an element to be present in a claimed reference, the reference must enable that element. *Scripps v. Genentech*. The absence of any mention of the adjustable positioning of pockets in ‘954 means that there is no disclosure or enablement of this element. Furthermore, the recitation by ‘954 that the pockets are “sewn” or “bonded” onto the pet sweater teaches away from having an adjustable pocket. There is no basis for a rejection of the claims under 35 U.S.C. § 102 based on the ‘954 reference. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Claims 2 & 4:

The Examiner finds the ‘954 reference, through its figures, teaches the location of the cavities as described in the present application. As previously mentioned, ‘954 shows that the pockets (14,21,22,20,34) are sewn or bonded to the pet sweater in a single location. There is no mention of these pockets being in any place other than as shown in these figures and further there is no discussion of the various anatomical regions where these pockets will be otherwise located.

For the reasons stated above with respect to claim 1, there is no basis for an anticipation rejection of claims 2 and 4 because the ‘954 reference neither teaches, suggests or enables the adjustable and strategically located pocket element. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Claims 5, 7, 8, 10, 12 and 16:

Examiner is of the opinion that the ‘954 reference anticipates claims 5&7 because ‘954 teaches that pouch 40 can be filled with a substance to generate heat via chemical reaction, or by slowly releasing the heat stored in a previously heated object. (Column 5, lines 52-67). As a first matter, the pockets are not the same pockets as those described in the current invention because the pockets are sewn or bonded to the pet sweater in a single location on said pet sweater. As discussed above for claim 1, this is

fatal to Examiner's argument that the '954 reference anticipates the current invention. Nonetheless, Applicant addresses further differences between the cited reference and the current invention. The '954 reference addresses only the delivery of heat, and thus is not a temperature altering device as in the current invention because temperature altering refers to both the increase and the decrease of a temperature.

Examiner is of the opinion that the '954 reference anticipates: (1) claim 8 because the pocket of '954 is sealable with a snap; (2) claim 10 because the heat element of '954 can be removed from the pocket, heated and returned to the pocket; (3) claim 12 because '954 has a fabric like material that allows heat transfer through the garment to the animal; and (4) claim 16 because the animal in '954 is a dog. Again, the pockets of the '954 reference are not the same as in the current invention (see arguments from claim 1, above), and, therefore, this element of these claims is not taught, suggested or enabled by '954. Further, '954 does not teach, suggest or enable a pocket having a material that will reflect temperature, both cold and hot temperatures, towards the body of the animal for maximum efficiency of temperature transfer.

The '954 reference does not teach, suggest or enable the device of the current application as claimed. This reference is merely teaching a cover (pet sweater) that has a pocket for holding a heating element. There is no teaching, suggestion or enablement of an animal cover that has adjustable pockets wherein these pockets are adjusted to target a temperature altering regimen to a specific location on an animal's body, these locations being joints, muscles and other anatomy on a variety of animals. Absent teaching, suggestion and enablement there is no anticipation. For this reason, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of these claims.

Claims 18, 20, 21, 23 and 25:

The Examiner is of the opinion that the '954 reference teaches the method of delivering a temperature-altering regimen as described in the current application. Applicants traverse Examiner's rejection and respectfully request that the rejection is withdrawn and the claims allowed.

According to *Key Pharmaceuticals Inc.*, a determination of anticipation requires first that the claim is construed and then is compared to the prior art. Construction of the current claims for a method for delivering a temperature altering regimen reveals that these claims are directed towards a temperature altering regiment that is specifically targeted to a location on the user's body. This is supported by the specification. At page 3 line 28 to page 4 line 3 the specification discloses that the device delivers a temperature altering regimen to a specific location on a horse's body, and that the device is adjustable thereby allowing the temperature altering device to precisely fit a variety of differently sized animals and target a variety of body areas. Also, the cavities are strategically located to contact spine, spinal muscles, shoulder muscles, hip muscles, stifle joint, c-spine and associated muscles. (Page 4 line 26 to page 5 line 4). In fact, the cavities can be located at any portion of the horse blanket that is desired. (Page 5 line 5). One example set out in the specification is locating a cavity on the flap of the horse blanket so that the cavity comes in contact with the stifle joint, inner thigh, groin or other regional anatomy and adjusting the cavity along the flap for proper positioning of the cavity with respect to the desired anatomical target. (Page 5 line 25 to page 6 line 2 and page 6 line 12 to line 26). Such a direct and targeting use of cavities and heating means within these cavities is neither disclosed, taught, suggested or enabled for the pet sweater of the '954 reference.

Applicant respectfully requests that the Examiner reconsider the rejection of claims 18, 20, 21, 23 and 25 as being anticipated by the '954 reference. As has been discussed above, '954 does not teach, suggest or enable the method of these claims, so there is no basis for anticipation of these claims by said reference. Applicant, therefore, also respectfully asks that the Examiner withdraw the rejection and allow these claim to issue.

Uhr, German Patent Document DE20021260U1 (DE260)

Claims 1-5, 7, 16-18, 21, 23, 25 and 26 are presently rejected under 35 USC § 102(b) as being anticipated by Uhr, German Patent Document DE20021260U1 (DE260). Examiner, referencing the abstract of this untranslated patent, has formed the

opinion that ‘260 teaches the animal cover and method for its use as claimed in the current invention. For the reasons set forth below, this rejection is traversed and the Examiner is respectfully asked to reconsider and withdraw this rejection.

Claims 1-4:

It is the Examiner’s opinion that DE260 teaches the animal cover 1 comprising a body having an interior and an exterior side; a plurality of cavities 2 strategically located within the body; and a temperature altering device. This is simply not the case. DE260 merely adds pockets to a horse blanket and delivers warming or cooling to the horse via a heat pad. The figures, particularly figure 1, depict that these pockets are located in a single area of the horse blanket, which at best would deliver the warming or cooling between the horse’s withers and croup and maybe shoulders. There is no indication that these pockets are adjustable, allowing for the precise targeting of a particular anatomy of the horse. Similarly, it is not disclosed in DE260, how these pockets could be adjusted so that the shoulder pocket would directly hit the shoulder of a variety of differently sized horses. The pockets of the DE260 blanket, therefore, can only come in close vicinity of the shoulder of a variety of differently sized horses, and fail to precisely hit the shoulder as required. This is unlike the adjustable and specific targeting of the pockets, and temperature altering devices within, to an anatomical location of the user as described and claimed in the current invention.

Review of figure 1 from DE260 shows that the animal cover is labeled 1. Review of figure 4 shows that the material of animal cover 1 divides into layers 1a and 1b to form a pocket 2. Close review of figure 4 shows that layers 1a and 1b are bordered by structure 9, which in the text of the DE260 patent is associated with the word “nähten”. The German word “nähten” translates to the English word “seams”, thus these pockets are sewn to the horse blanket forming seams 9, and therefore are not adjustable as are the cavities of the current invention. (Translation of word “nähten” was via AltaVista’s Babel Fish - <http://babelfish.altavista.com/tr>). Having the pockets sewn within the horse cover makes the pockets affixed. This teaches away from the adjustable pockets of the current application invention.

The pockets of DE260 are affixed to the horse blanket at a single location. This location is likely between the withers and croup of the horse and the shoulders. It is

unclear how such a disclosure anticipates the adjustable cavities of the current invention wherein specific anatomy of the user can be targeted for the delivery of a temperature altering regimen. The current invention discloses that the cavities can be adjusted to precisely target a region. The adjustable pockets of the current invention can target the user's spine, spinal muscles, hips, shoulders, stifle, groin, thoracic cavity and/or inner thigh. Regardless of the size of the user, a single cover can target these and other anatomical regions by way of the adjustment feature. Cavities of the invention are adjustably positioned so that they contact directly the selected anatomical region. This is unlike the affixed pockets of DE260 wherein the pockets will generally contact only the spine region of the user. Absent a teaching or suggestion and absent enablement there is no basis for an anticipation rejection. Furthermore, in light of DE260 teaching away from the adjustable cavities of the current application, there can be no anticipation. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-4.

Claims 5, 7, 16 and 17:

Examiner is of the opinion that DE260 anticipates: (1) claims 5 and 7 because the pockets of DE260 contain a temperature altering device; (2) claim 16 because the animal is a horse; and (3) claims 16 and 17 because the cover can be a horse cover and the animal can be a horse. Again, the pockets of the DE260 reference are not the same as in the current invention (see arguments from claims 1-4, above), and, therefore, this element of these claims is not taught, suggested or enabled by DE260.

The DE260 reference does not teach, suggest or enable the device of the current application as claimed. This reference is merely teaching a horse cover that has an affixed pocket for holding a heat pad, and that these affixed pockets will generally touch the croup, withers and shoulder area of a horse, so long as the horse is the correct size to fit the design of the cover. There is no teaching, suggestion or enablement of an animal cover that has adjustable pockets wherein these pockets are adjusted to target a temperature altering regimen to a specific location on an animal's body, these locations being joints, muscles and other anatomy on a variety of different sized animals. Absent teaching, suggestion and enablement there is no anticipation. For this reason, Applicant

respectfully requests that the Examiner reconsider and withdraw the rejection of these claims.

Claims 18, 21, 23, 25 and 26:

The Examiner is of the opinion that the DE260 reference teaches the method of delivering a temperature-altering regimen as described in the current application. Applicants traverse Examiner's rejection and respectfully request that the rejection is withdrawn and the claims allowed.

According to *Key Pharmaceuticals Inc.*, a determination of anticipation requires first that the claim is construed and then is compared to the prior art. Construction of the current claims for a method for delivering a temperature altering regimen reveals that these claims are directed towards a temperature altering regiment that is specifically targeted to a location on the user's body. This is supported by the specification. At page 3 line 28 to page 4 line 3 the specification discloses that the device delivers a temperature altering regimen to a specific location on a horse's body, and that the device is adjustable thereby allowing the temperature altering device to precisely fit a variety of differently sized animals and target a variety of body areas. Also, the cavities are strategically located to contact spine, spinal muscles, shoulder muscles, hip muscles, stifle joint, c-spine and associated muscles. (Page 4 line 26 to page 5 line 4). In fact, the cavities can be located at any portion of the horse blanket that is desired. (Page 5 line 5). One example set out in the specification is locating a cavity on the flap of the horse blanket so that the cavity comes in contact with the stifle joint, inner thigh, groin or other regional anatomy and adjusting the cavity along the flap for proper positioning of the cavity with respect to the desired anatomical target. (Page 5 line 25 to page 6 line 2 and page 6 line 12 to line 26). Such a direct and targeting use of cavities and heating means within these cavities is neither disclosed, taught, suggested or enabled for the pet sweater of the '954 reference.

Applicant respectfully requests that the Examiner reconsider the rejection of claims 18, 21, 23, 25 and 26 as being anticipated by the DE260 reference. As has been discussed above, DE260 does not teach, suggest or enable the method of these claims, so there is no basis for anticipation of these claims by said reference. In fact, DE260 teaches

away from an adjustable cavity by having affixed pockets on the horse cover. Applicant, therefore, also respectfully asks that the Examiner withdraw the rejection and allow these claim to issue.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Beeghly et al., United States Patent Number 5,537,954 ('954) alone

Claims 6, 9, 11, 19, 22 and 24 are rejected as being obvious and unpatentable over Beeghly et al., United States Patent Number 5,537,954 ('954) alone. As applied to the claims, the rejection is respectfully traversed.

As is described above, the invention of the current application is significantly different from the '954 reference. There is no teaching of adjustable cavities in the '954 reference, and, in fact, '954 teaches away from this element of the claims by teaching an affixed pocket. There is also no teaching in '954 to target different anatomical regions of the cover user by way of adjustable pockets. Instead, the affixed pockets of '954 teach away from such adjustability.

The artisan of ordinary skill would have no motivation to alter the '954 invention. The art itself must suggest the modification to produce the claimed invention. *In re Gordon*, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Adjustable cavities cannot be suggested by affixed pockets, so the current invention is not suggested by '954. Additionally, the requisite expectation of success is not present. There is no indication how, for example, the pockets of the pet sweater in '954, which are sewn in a single location near the thoracic cavity of the dog, would be used to deliver a temperature altering regimen precisely to the inner thigh of that animal. Finally, the '954 reference does not teach all of the elements of the current invention; in fact there is a teaching away from the invention. The absence of any of the elements of the claimed invention from the teachings of the prior art is fatal to the existence of a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

Thus, with respect to the Examiner's rejections: (1) claim 6 having the temperature altering device permanent or removable in the cavity; (2) claim 9 heating the temperature altering device within the cavity; (3) claim 11 fabricating the cover from a

material that wicks away moisture to prevent chapping; (4) claim 19 a method step for heating the temperature altering device; (5) claim 22 a method step of wrapping the pet sweater around the thigh of the dog to deliver temperature to that area; and (6) claim 24 a method step of repeating the temperature altering regimen for prolonged treatment duration, in each rejection the element of having a cover with adjustable cavities is absent. Additionally, there is no motivation in ‘954 for making the pockets adjustable, and this flaw is not cured by way of wrapping a pet sweater around the thigh of a dog, as Examiner suggests. The pockets of the ‘954 pet sweater are disclosed as being sewn in a single location. There is no reasonable probability of successfully accomplishing the targeted temperature altering regimen using the device of ‘954. Thus there is no *prima facie* case of obviousness present.

Applicant respectfully requests that the Examiner reconsider and withdraw the obviousness rejection on claims 6, 9, 11, 19, 22 and 24.

Beeghly et al., United States Patent Number 5,537,954 ('954) combined with Tadauchi, et al., Japanese Patent Number JP 10113088 A (JP088)

Claims 13-15 are rejected as being obvious and unpatentable over Beeghly et al., United States Patent Number 5,537,954 ('954) combined with Tadauchi, et al., Japanese Patent Number JP 10113088 A (JP088). As applied to the claims, the rejection is respectfully traversed.

The scope and limitations of the '954 reference have been discussed above, and are aptly applied here as well. JP088 discloses a harness for cooling the head of a horse comprising a head harness, and alternatively a neck cover connected to the head harness using hook and loop fastening. The cooling of the horses head takes place using a cooling material that is attached to the head harness using hook and loop. These cooling materials are placed at the forehead region of the horse's head while the harness fasteners are placed at the throat latch of the horse's head. There is no disclosure in JP088 that the cooling materials are adjustable. Further, JP088 teaches only the cooling of the head of a horse, and more specifically, the forehead region of the horse, and the cooling of the neck of a horse.

A *prima facie* case of obviousness requires a motivation to combine the references, a reasonable expectation of success and a teaching or suggestion of all of the elements of the claims. (See, e.g., *In re Fine*; *In re Skinner*, 2 USPQ2d 1788, 1790 (1986); *Amgen Inc. v. Chugai Pharm. Co.*, F.2d 1200, 1209 (1991); and *In re Wilson*, 424 F.2d 1382, 1385 (1970)). The teaching or suggestion, as well as the expectation of success, must come from the prior art, not applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493 (1991).

The Examiner has rejection claims 13-15 as being obvious because; (1) the Velcro (hook and loop) of JP088 can be combined with the affixed pockets of '954 to create pockets that are adjustable; (2) one could add a flap region to the '954 cover and then provide a pocket to treat the stifle, inner thigh, outer thigh or other region; and (3) add a flap to the '954 cover and make it adjustable using the Velcro of JP088. Examiner is improperly using hindsight in this rejection. The teaching of adjustable cavities comes only from Applicant's disclosure. Neither JP088 nor '954 discuss having adjustable pockets or even a need for adjustable pockets. Further, there is no indication of successfully creating adjustable pockets using the Velcro of JP088. This is particularly true in light of JP088 disclosing that the harness body is made of vinyl leather, which is not compatible with the hook or loop member of a Velcro fastener system. The cooling material is reportedly attached and detached at required parts of the surface. Taking this disclosure in light of the drawings, the required part of the surface is the surface of the head harness near the forehead region of the horse. Thus, JP088 teaches a head harness made of vinyl and having one of the hook or loop members of Velcro at the forehead region of this harness for attaching a cooling material having the other complementary hook or loop member. There is no teaching of adjustably positioning these cooling materials in JP088, and merely reciting the use of Velcro as an attachment means without something more does not make the cooling materials adjustable. Furthermore, neither JP088 nor '954 teach a specifically targeting a variety of anatomical regions from the c-spine to the stifle joint and various specific location in between using the pockets.

There is no *prima facie* case of obviousness. Furthermore, Examiner is improperly using the teachings of the current invention in hindsight to attribute otherwise non-existent teachings to these reference in supporting his obvious rejection. As such,

the obviousness rejection cannot stand. Applicant respectfully requests that the Examiner withdraw the rejections of claims 13-15.

**CONCLUSION**

Applicant respectfully submits that claims 1- 26 are in condition for allowance, and earnestly solicits a notice to such effect. Should any issues or questions remain, the Examiner is encouraged to telephone the undersigned at 858.450-0099 x303 so that they may be promptly resolved without the need for an additional formal action and response thereto.

Respectfully submitted,

Date: Apr. 1 21, 2005

  
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